

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MATTHEW D. MOTTIER, MIKE M. ALBERT
and JOSHUA P. KIEM

Appeal No. 1998-2729
Application 08/220,851

ON BRIEF

Before BARRETT, HECKER and DIXON, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 19 through 24, 26 through 31 and 33 through 38, all claims pending in this application.¹

¹ Both the Appellants (brief-page 2) and the Examiner (answer-page 4) have misstated the precise claims under appeal. Since claims 19, 26 and 33 (all pending independent claims) stand rejected under 35 U.S.C. § 112, first paragraph, all claims dependent therefrom also stand rejected on the same grounds (i.e., all pending claims in this application).

Appellants' invention relates to a radio with silent and audible alerts for alerting a user that a call has been received. Silent alerts, such as a vibrating device, can be used where the ambient noise level is so high that the audible alert would not be heard. On the other hand, a silent alert would not be effective (i.e., felt) when the radio is not carried by the user, such as when the radio is intercoupled with an external power supply or some other holder away from the user's body. The invention provides for periodically generating a first (e.g., silent) alert for a number of cycles, and a second (e.g., audible) alert for a number of cycles. Each cycle includes a first time period when the alert is generated followed by a second time period when the alert is not generated.

Representative independent claim 19 is reproduced as follows:

19. A radio for communicating radio frequency (RF) call signals comprising:

an antenna for receiving a first RF call signal and transmitting a second RF call signal;

a transmitter coupled to the antenna for generating the second RF call signal;

a receiver coupled to the antenna for receiving the first RF call signal;

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a first generator for periodically generating, when enabled, a silent alert for a first predetermined number of cycles, wherein each cycle of the first predetermined number of cycles includes a first time period when the silent alert is generated followed by a second time period when the silent alert is not generated;

a second generator for periodically generating, when enabled, an audible alert for a second predetermined number of cycles, wherein each cycle of the second predetermined number of cycles includes a first time period when the audible alert is generated followed by a second time period when the audible alert is not generated; and

a processor coupled to the receiver for enabling the first generator when the first RF call signal is received, and, after at least one of the first predetermined number of cycles, enabling the second generator.

The Examiner does not rely on any references.

Claims 19 through 24, 26 through 31 and 33 through 38 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which lacks support in the specification.

The rejections of claims under non-obviousness-type and obviousness-type double patenting have been rendered moot via the execution of a terminal disclaimer (paper no. 24).

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief, and answer for the respective details thereof.

OPINION

It is our view, after consideration of the record before us, that the disclosure in this application does comply with the written description requirement of 35 U.S.C. § 112.

At the outset, we note that Appellants have indicated on page 3 of the brief that all pending claims stand or fall together. Therefore, we will treat claim 19 as the representative claim.

Initially, we note that the Examiner's reasoning for lack of "support" for the claimed invention herein, implicitly refers to the written description portion of this statutory provision. ***In re Higbee***, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976). The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity, to those skilled in the art, that they were in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." ***Vas-cath, Inc. v. Mahurkar***, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The manner in which the specification as filed meets the written description requirement is not material. The

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requirement may be met by either an express or an implicit disclosure. **In re Wertheim**, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). An invention claimed need not be described in **ipsis verbis** in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. **In re Lukach**, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The question is not whether an added word was the word used in the specification as filed, but whether there is support in the specification for the employment of the word in the claims, that is, whether the concept is present in the original disclosure. **See In re Anderson**, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

In the instant case the Examiner finds no support in the specification for the claim language defining a cycle as:

a first period when the alert is generated followed by
a second period when the alert is not generated
[answer-page 4]

The Examiner concludes:

This alert can be a sinusoidal wave. A sinusoidal, or a triangular wave, especially those with a DC offset, and a square wave with DC offset would all be periodic and cyclic yet none of these signals would include periods of time in which the alert was "on" and periods of time in which the alert was "off". [Answer-page 5.]

Appellants cite dictionary definitions and portions of their specification (brief-pages 3 and 4). We find clear support for

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the objected to language at page 7, lines 10-12 of the specification. Herein Appellants' specification states:

The silent and audible alert may comprise a continuous alert **or a periodic alert (i.e., alert cycles)**.
[Emphasis added.]

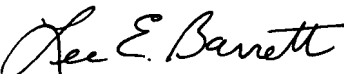


Thus, we find Appellants claim alert cycles as opposed to a continuous alert. As we understand, an audible alert could consist of three rings for example. This would equate to three cycles. Quite obviously, a **silent period** would be necessary in each cycle to distinguish one ring (i.e., cycle) from the next. Although the Examiner's conclusions regarding sinusoidal waves may be accurate, sinusoidal waves are not pertinent to Appellants' context. In fact, the Examiner's sinusoidal and triangular wave examples are not mentioned nor are they relevant to Appellants' disclosure.

Accordingly, we find that the specification does support the claim language, and meets the written description requirement of 35 U.S.C. § 112. Consequently, we will not sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection.

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The decision of the examiner rejecting claims 19 through 24,
26 through 31 and 33 through 38 is reversed.

REVERSED

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LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART N. HECKER)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JOSEPH L. DIXON)	
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